



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re REISSUE PATENT APPLICATION of

Atty. Ref: 36-1008

ATTWATER et al.

Serial No.: 09/930,395 (Reissue of Patent No. 5,940,793)

Filed: August 16, 2001

For: VOICE-OPERATED SERVICES

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Hon. Commissioner of Patents  
and Trademarks  
Washington, DC 20231

Sir:

FACTUAL DECLARATION OF ALISON D. SIMONS

Alison D. Simons hereby declares and states as follows:

I am currently a patent attorney working in the private British law firm  
Dummett Copp, having offices at 25 The Square, Martlesham Heath, Ipswich, Suffolk  
IP5 3SL, Great Britain.

I am a named co-inventor of U.S. Patent No. 5,940,793 (hereinafter the "U.S. '793  
patent") issued August 17, 1999 from U.S. Application No. 08/817,673 (hereinafter the  
"U.S. '673 application") filed April 21, 1997 as a U.S. national stage filing of  
International Application No. PCT/GB95/02524 (hereinafter the "PCT '524  
application") filed October 25, 1995 and claiming the benefit of foreign priority under 35  
U.S.C. 119 of European Application No. 94307843 filed October 25, 1994.

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I was employed by British Telecommunications public limited company (Assignee of record in the subject application) from September 1982 to on or around April, 2001. Specifically, I was employed by Assignee as a technical engineer from September 1986 to January 1996. I later became employed by the Intellectual Property Department of Assignee in January 1996, first as a trainee from January 1996 to in or around September, 2000 and later as an inhouse patent attorney from in or around October, 2000 to in or around April, 2001. One of my supervisors while working as a trainee in the Intellectual Property Department was Bob Semos, an in-house patent attorney working in the same department.

In or around February, 1998 I took over responsibility of working with Assignee's retained outside U.S. counsel (i.e., the attorneys of record) on the prosecution of the U.S. '673 application on behalf of Assignee under the supervision of Bob Semos. I took over this responsibility from Juliet Hibbert, an in-house patent attorney previously working in Assignee's Intellectual Property Department, as Ms. Hibbert ended her employment with Assignee in or around February, 1998. At approximately the same time, I took over responsibility of prosecuting related European Application No. 95934749 (hereinafter the "EP '749 application") filed February 26, 1995 and took over responsibility of working with Assignee's retained outside New Zealand counsel on the prosecution of New Zealand Patent Application No. 294296 (hereinafter the "NZ '296 application") filed in February 26, 1997 under the supervision of Bob Semos. Like the U.S. '673 application, the EP '749 and NZ '296 applications are national phase applications of the PCT '524 application.

After reviewing the U.S. '673 application, an Official Action dated September 2, 1998, cited prior art and a letter dated September 9, 1998 from outside U.S. counsel, I wrote a letter to outside U.S. counsel dated February 19, 1999 containing a response strategy to the September 2 Official Action. A Response dated March 2, 1999 was filed in the U.S. Patent Office by outside U.S. counsel on the basis of this strategy. A Notice of Allowance dated March 25, 1999 was issued in response to the March 2 response and was reported to me in a letter from outside U.S. counsel dated March 31, 1999. The U.S. '673 application issued as the U.S. '793 patent on August 17, 1999.

On information and belief, Assignee received an international search report dated May 31, 1996 from the International Search Authority during the prosecution of the PCT '524 application.

On information and belief, Assignee received a nonunity objection dated December 9, 1997 from the European Patent Office during the prosecution of the EP '749 application, and in response, Ms. Hibbert requested payment of the necessary fees on December 16, 1997 for additional searches for separate inventions. A supplemental search report citing all of the references previously cited in the international search report plus additional references (hereinafter the "newly cited references") was issued by the European Patent Office on October 22, 1998 in the EP '749 application and received by Assignee on November 2, 1998.

After reviewing the EP '749 application, an official action dated June 4, 1999 from the European Patent Office and the international and supplemental search reports, I prepared a response to the European Official Action. After Bob Semos signed the

response, I filed the same on March 9, 2000. In the March 9 response, those claims which were objected to as not complying with the European Patent Office's unity of invention provisions were canceled. I did not study in detail the newly cited references of the supplemental search report since those references were cited as being possibly pertinent to the claims that were canceled. In an email dated March 29, 2000 to David Attwater, another named co-inventor, I commented on the possibility of filing a divisional application in the European Patent Office for some of those claims canceled during the prosecution of the EP '749 application.

After reviewing the NZ '296 application, an official action dated August 7, 1997 from the New Zealand Patent Office and cited references including document WO 93/05605 (hereinafter "WO '605") in or around January, 1999, I wrote a letter containing a response strategy to Assignee's retained outside New Zealand counsel. A response dated February 4, 1999 was filed by outside New Zealand counsel on the basis of my response strategy. The NZ '296 application issued as New Zealand Patent No. 294296 on August 11, 1999. On information and belief, WO '605 was cited in the August 7, 1997 official action as being possibly pertinent to a claim which was canceled in the February 4, 1999 response to satisfy a non-unity of invention objection. I instructed outside New Zealand counsel to file a New Zealand divisional patent application on behalf of Assignee in or around February, 1999. New Zealand divisional patent Application No. 334083 (hereinafter the "NZ '083 application") was filed on February 5, 1999. After receiving and reviewing a non-unity objection issued by the New Zealand Patent Office in the NZ '083 application, I instructed Assignee's retained outside New Zealand

counsel to cancel the claims to which WO '605 was cited as being possibly pertinent. The NZ '083 application issued as New Zealand Patent No. 334083 on January 11, 2001.

To the best of my recollection and belief, I was aware of the newly cited references of the supplemental search report issued in the prosecution of the EP '749 application and WO '605 cited in the prosecution of the NZ '296 application at some point during the pendency of the U.S. '673 application. I was not, however, acutely aware of or did not fully appreciate at that time the duty to disclose known prior art to the U.S. Patent Office as I am today. During the pendency of the U.S. '673 application, I was still a trainee in the Intellectual Property department under the supervision of Mr. Semos. Since I was not acutely aware of or did not fully appreciate the duty to disclose known prior art to the U.S. Patent Office at that time, I did not inform outside U.S. counsel about the newly cited references of the supplemental search report or WO '605 during the pendency of the U.S. '673 application.

I ended my employment with Assignee on or about April, 2001. On information and belief, Barry Lloyd an in-house patent attorney working in Assignee's Intellectual Property department, took over the prosecution of the EP '749 application.

In or about August, 2001, Mr. Lloyd reminded me about the existence of the newly cited references of the supplemental search report. Mr. Lloyd soon thereafter reminded me about the existence of WO '605. On information and belief, Mr. Lloyd also discussed the existence of the newly cited references of the Supplemental Search Report and WO '605 with Mr. Semos. Mr. Lloyd and I concluded that the inadvertent failure to disclose the newly cited references of the supplemental search report and WO

'605 to the U.S. Patent Office during the prosecution of the U.S. '673 application was an inadvertent error.

I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

*Adimons*

ALISON D. SIMONS

Date: 31/01/02

Signed by ALISON  
DIANE SIMONS in  
my presence this 31<sup>st</sup>  
day of January 2002

*S.M.J. Leach*

S.M.J. LEACH  
19 CHURCH STREET  
WOODBIDGE, SUFFOLK  
Notary Public